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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,910	01/12/2006	Jonathan Alexander Terrett	2543-1-040PCT/US	1458
23565	7590	08/12/2010		
KLAUBER & JACKSON 411 HACKENSACK AVENUE HACKENSACK, NJ 07601			EXAMINER HOLLERAN, ANNE L	
			ART UNIT	PAPER NUMBER
			1643	
			MAIL DATE	DELIVERY MODE
			08/12/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/524,910	<b>Applicant(s)</b> TERRETT, JONATHAN ALEXANDER	
	<b>Examiner</b> ANNE L. HOLLERAN	<b>Art Unit</b> 1643	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 33-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

The amendment filed 6/7/2010 is acknowledged.

Claims 33-42 are pending and examined on the merits.

#### ***Claim Rejections Withdrawn:***

##### ***Claim Rejections - 35 USC § 112***

The rejection of claims 34, 35 and 38 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendment to claims 34, 35 and 38.

#### ***Claim Rejections Maintained:***

##### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 33-42 remain/are rejected under 35 U.S.C. 102(e) as being anticipated by Mack (US 7,189,507; Mar. 13, 2007; effective filing date Apr. 12, 2002) for the reasons of record.

Applicants state that Mack discloses methods for diagnosing ovarian cancer comprising determining the expression of a gene as set forth in Tables 1-20 of the reference, wherein PTK7

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is listed as one of hundreds of other gene sequences, and that contrary to the examiner's assertion Mack does not disclose or suggest a method of screening and/or diagnosis of breast, pancreatic, lung, bladder or kidney cancer or osteosarcoma in a subject. Applicants state that the presently claimed method of screening is directed to biological samples taken from the compartments where the listed carcinomas are suspected, and that this delimits and distinguishes from the teachings of Mack.

Applicants statement that the purpose of the claimed methods is to screening samples for the presence of certain cancers and that the tissues listed are those suspected of having one of the listed carcinomas, and the purpose of the claimed methods delimits and distinguishes the teachings of Mack is not found persuasive. The claims are drawn to methods comprises detecting or quantifying a PTK7 polypeptide comprising or consisting of the amino acid sequence of SEQ ID NO: 1 in a biological sample selected from breast, pancreatic, lung, bladder, kidney or bone tissue obtained from a subject. This is the same step as that taught by Mack because Mack teaches methods comprising the detection and/or quantification of SEQ ID NO: 1 and Mack teaches tissues such as lung, kidney or bone as samples for detecting and/or quantifying a PTK7 polypeptide. The fact that Mack also teaches detecting and/or quantifying SEQ ID NO: 1 in ovarian tissues does not place Mack outside of the scope of the claims. The fact that Mack does not teach the intended use of the claims does not place Mack outside of the scope of the claims. Therefore, the rejection is maintained for the reasons of record.

Claims 33-42 remain rejected under 35 U.S.C. 102(e) as being anticipated by Gish (US PGPub 2007/0014801 A1; published Jan. 18, 2007; effective filing date Oct. 12, 2001) for the reasons of record.

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Applicants state that Gish is in certain respects similar in its focus and disclosure and corresponding distinction from the presently claimed invention to Mack discussed above, because Gish teaches detection of prostate cancer.

This is not found persuasive because Gish teaches the detection and/or quantification of SEQ ID NO: 1 in breast or lung tissue. Therefore, Gish teaches a method with the same active steps as that of the claimed methods. Therefore, the rejection is maintained for the reasons of record.

### ***Conclusion***

No claim is allowed. The disclosure of US20070059712 is cumulative to that of Gish (US 2007/0014801).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Holleran, whose telephone number is (571) 272-0833. The examiner can normally be reached on Monday through Friday from 9:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, can be reached on (571) 272-0832. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Official Fax number for Group 1600 is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Anne L. Holleran  
Patent Examiner  
/Alana M. Harris, Ph.D./

Primary Examiner, Art Unit 1643